

### REMARKS

Claims 1-39 are pending with claims 1, 17, 26 and 34 being independent. None of the claims have been amended. No new matter has been added.

In light of the following remarks, a formal notice of allowance is respectfully requested.

#### **Rejections Under 35 U.S.C. § 103 Based on Sakoda and Van Erlach**

Claims 1-4, 6, 7, 17, 21 and 34-36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,665,533 to Sakoda ("Sakoda") in view of U.S. Patent Application Publication No. 2003/0179229 to Van Erlach ("Van Erlach"). The rejections and their underlying reasoning are respectfully traversed in their entirety.

#### **Claim 1 and its dependent claims**

The Office concedes that Sakoda fails to teach or suggest at least the claimed "selecting one of the stored advertisements to present on the mobile device during at least a portion of the wireless communication if the determined time is longer than a threshold time." (See Office Action dated March 20, 2008 at page 3.) The addition of Van Erlach fails to cure the deficiencies of Sakoda.

The Office contends that Van Erlach teaches "...selecting an advertisement based on the time available for an advertisement." (See *id.*) However, the relevance of such teaching in Van Erlach is not clear. As describe above, claim 1 recites in part "selecting one of the stored advertisements to present on the mobile device during at least a portion of the wireless communication if the determined time is longer than a threshold time." (Emphasis added.) The "determined time" refers to the "time required to complete the wireless communication." Thus, the time required to complete the wireless communication, such as downloading a file, is determined and that time is compared to a threshold time. Only if that determined time is longer than the threshold time, an advertisement is selected based on this condition.

In contrast to claim 1, Van Erlach teaches determining time length of already selected advertisements and fitting them into predetermined advertisement time slots with predetermined time lengths. (Van Erlach at paragraph [0011].)

This information is supplied to an intelligent router which selects ads from a database on an ad server whose designated target audience, time slot, television show characteristics and other parameters match those of input from each properly equipped biometric data gathering unit. Selected ads are compared for time length to available or given time in the ad slot and a digital ad compression and decompression engine runs the ad to fit the assigned time.

(Id.)

It's important to note Van Erlach teaches that “[s]elected ads are compared for time length...” Thus, the ads are already selected before comparing the length of the ads. This is because the ads are selected in Van Erlach based on information obtained from the biometric data of each user. In addition, the already selected ads in Van Erlach are “fit” into the ad slots using “digital ad compression and decompression engines.” This indicates that the time lengths of the selected ads in Van Erlach are compared to determine how much to compress the ads. In contrast to claim 1, the ads in Van Erlach are not selected based on the condition of “if the determined time is longer than a threshold time.”

Further, the rejection is defective because Office fails to identify the features in Van Erlach that the Office contends to be the same as the claimed “determined time”, the “threshold time” and the condition of “if the determined time is longer than a threshold time.” If the rejections are maintained in the next office action, Applicant requests that the Office clearly identify these claimed features in Van Erlach.

For at least these reasons, the compression of the already selected ads in Van Erlach cannot reasonably be construed as the claimed “selecting one of the stored advertisements to present on the mobile device during at least a portion of the wireless communication if the determined time is longer than a threshold time.”

For at least these reasons, claim 1 is allowable over the proposed combination of Sakoda and Van Erlach. Claims 2-4, 6 and 7 depend from claim 1 and are allowable for at least the same reasons.

Claim 17 and its dependent claims

Claims 17 is allowable for at least reasons similar to claim 1 above. Claims 21 depend from claim 17 and are allowable for at least the same reasons.

Claim 34 and its dependent claims

Claim 34 is allowable for at least reasons similar to claim 1. Also, Claim 34 is allowable for additional reasons. In particular, the proposed combination of Sakoda and Van Erlach fails to teach or suggest at least the claimed “presenting one or more of a rotation of the stored advertisements on the mobile device during the period of delay in the wireless communication session if the determined time is longer than a threshold time.” (Emphasis added.)

Again, the Office erroneously contends that Van Erlach teaches “selecting an advertisement based on the time available for an advertisement.” (See Office Action dated March 20, 2008 at pages 5-6.) As describe with respect to claim 1, Van Erlach teaches selecting advertisements based on the information obtained from the biometric data and not based on the time lengths of the ads. The time lengths of the ads selected based on the biometric data are identified in order to “fit” the ads into the ad slots by compressing them.

To this mischaracterization of Van Erlach, the Office contends to add the teachings of Sakoda, which allegedly describes displaying “successively viewed advertisements.” (See *id.*) However, the teachings of Sakoda fail to support the contention.

In contrast to claim 34, Sakoda teaches selecting an advertisement from a plurality of advertisements based on “[t]he 30<sub>j</sub> assign[ing] priorities to the advertisements.” (See Sakoda at column 10, lines 55-62. Selecting an advertisement based on the priorities in Sakoda is not the same as the claimed “presenting one or more of a rotation of the stored advertisements on the mobile device during the period of delay in the wireless communication session if the determined time is longer than a threshold time.” (Emphasis Added.) The priorities assigned in Sakoda are not based on the above claimed condition of “if the determined time is longer than a threshold time.”

Further, as correctly identified by the Office, Sakoda teaches that [t]he terminal 30<sub>j</sub> ends the display/reproduction of the advertisement as soon as the storing of information transmitted via the traffic channel (TCH) in the storage 34 (store contents) has been completed..." (See Sakoda at column 8, lines 62-67.) Thus, the displayed advertisements in Sakoda can be ended in midstream as soon as the storing of the information ends. This is because Sakoda does not use the claimed condition of "if the determined time is longer than a threshold time."

For at least these reasons, the proposed combination of Sakoda and Van Erlach fails to teach or suggest each and every feature of claim 34. Namely, the proposed combination fails to teach or suggest at least the claimed "presenting one or more of a rotation of the stored advertisements on the mobile device during the period of delay in the wireless communication session if the determined time is longer than a threshold time." (Emphasis added.)

Claims 35-36 depend from claim 34 and are allowable for at least the same reasons.

#### **Rejections Under 35 U.S.C. § 103 Based on Sakoda Van Erlach and Hamano**

Claims 8-13, 16, 18-20, 26-33 and 37-39 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sakoda in view of Van Erlach and further in view of U.S. Patent Application Publication No. 2002/0166127 to Hamano ("Hamano"). The rejections and their underlying reasoning are respectfully traversed in their entirety.

#### **Claims 8-13 and 16**

Claims 8-13 and 16 depend from claim 1 and are allowable over the proposed combination of Sakoda and Van Erlach. The addition of Hamano fails to cure the deficiencies of Sakoda and Van Erlach.

In contrast to claim 1, Hamano teaches displaying advertisements during "boot up" or "wake up" process. (See, e.g., Hamano at paragraphs [0030], [0035] and [0037].) The boot up and wake up process in Hamano are not related to any wireless communication and thus are not displayed "during at least a portion of the wireless communication..." as recited in claim 1. In addition, Hamano does not teach or suggest the claimed "determined time," the "threshold time" and the claimed condition of "if the determined time is longer than [the] threshold time." Thus, the proposed combination of Sakoda, Van Erlach and Hamano fails to teach or suggest at least

the claimed "selecting one of the stored advertisements to present on the mobile device during at least a portion of the wireless communication if the determined time is longer than a threshold time."

For at least these reasons, claims 8-13 and 16 are allowable over the proposed combination of Sakoda, Van Erlach and Hamano.

Claims 18-20

Claims 18-20 are allowable over the proposed combination for at least reasons similar to claim 8.

Claim 26 and its dependent claims

The Office contends that the claimed "wherein the advertising application on a mobile device presents the new advertisement during the delay if the delay is longer than a threshold time" is taught by Van Erlach. However, as described with respect to claim 1 above, Van Erlach does not teach or suggest the claimed "wireless communication that causes a delay on the mobile device." In contrast to claim 26, Van Erlach teaches compressing the selected advertisements to fit into a predetermined ad slots. (Van Erlach at paragraph [0011].) In addition, the selected advertisements are selected based on biometric data and not based on the claimed condition. Because Van Erlach does not teach or suggest a delay caused by a wireless communication, Van Erlach also does not determine whether a delay is longer than a threshold time. Thus, the proposed combination of Sakoda, Van Erlach and Hamano fails to teach or suggest each and every feature of claim 26.

For at least these reasons, claim 26 is allowable over the proposed combination of Sakoda, Van Erlach and Hamano. Claims 26-33 depend from claim 26 and are allowable for at least the same reasons.

Claim 37-39

Claims 37-39 are allowable for at least reasons similar to claims 8-10.

**Rejections Under 35 U.S.C. § 103 Based on Sakoda Van Erlach and Sanctis**

Claims 5 and 22-24 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sakoda in view of Van Erlach and further in view of U.S. Patent Application Publication No. 2005/0131837 to Sanctis et al. ("Sanctis"). The rejections and their underlying reasoning are respectfully traversed in their entirety.

Claim 5 depends from claim 1 and is allowable over the proposed combination of Sakoda and Van Erlach for at least the same reasons. The addition of Sanctis fails to alleviate the deficiencies of Sakoda and Erlach. As described in the reply dated January 23, 2008, Sanctis is directed to sending to a mobile device a mobile alert message that the user must acknowledge and manually read in order to view a message related to the alert. (See Sanctis, ¶¶ [0042]-[0044].) The system in Sanctis does not store a plurality of advertisements and does not select one of the stored advertisements to present to the mobile device, as recited in claim 1. Thus, even if combinable, which is not conceded, the proposed combination of Sakoda, Erlach and Sanctis fails to teach or suggest at least the claimed "selecting one of the stored advertisements to present on the mobile device during at least a portion of the wireless communication if the determined time is longer than a threshold time."

Claims 22-24 depend from claim 17 and are allowable over the proposed combination of Sakoda and Van Erlach. As described with respect to claim 5 above, the addition of Sanctis fails to cure the deficiencies of Sakoda and Erlach.

**Rejections Under 35 U.S.C. § 103 Based on Sakoda Van Erlach and Rakavy**

Claims 14-15 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sakoda in view of Van Erlach and further in view of U.S. Patent No. 5,913,040 to Rakavy ("Rakavy"). The rejections and their underlying reasoning are respectfully traversed in their entirety.

Claims 14-15 depend from claim 1 and are allowable over the proposed combination of Sakoda and Van Erlach for at least the same reasons. The addition of Rakavy fails to alleviate the deficiencies of Sakoda and Van Erlach.

In contrast to claims 14-15, Rakavy teaches “selecting advertisements and other information from a computer network database based on user defined preferences...” (See Rakavy at abstract.) Thus, Rakavy fails to teach or suggest the claimed “selecting one of presenting the stored advertisements to present on the mobile device during at least a portion of the wireless communication if the determined time is longer than a threshold time.”

Therefore, even if combinable, which is not conceded, the proposed combination of Sakoda, Van Erlach and Rakavy fails to teach or suggest at least the claimed “selecting one of the stored advertisements to present on the mobile device during at least a portion of the wireless communication if the determined time is longer than a threshold time.”

**Rejections Under 35 U.S.C. § 103 Based on Sakoda Van Erlach and Levin**

Claim 25 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sakoda in view of Van Erlach and further in view of U.S. Patent Application Publication No. 2002/0128908 to Levin (“Levin”). The rejections and their underlying reasoning are respectfully traversed in their entirety.

Claim 25 depends from claim 17 and is allowable over the proposed combination of Sakoda and Van Erlach for at least the same reasons. The addition of Levin fails to cure the deficiencies of Sakoda and Van Erlach.

In contrast to claim 25, Levin teaches a system for conducting “promotional campaigns” which includes conducting “electronic survey, including creating, publishing, and collecting and analyzing data generated by the survey.” (See Levin at paragraph [0058] and FIG. 1.) However, similar to Sakoda and Van Erlach, Levin fails to teach or suggests at least the claimed “selecting one of presenting the stored advertisements to present on the mobile device during at least a portion of the wireless communication if the determined time is longer than a threshold time.”

Therefore, even if combinable, which is not conceded, the proposed combination of Sakoda, Van Erlach and Levin fails to teach or suggest at least the claimed “selecting one of the stored advertisements to present on the mobile device during at least a portion of the wireless communication if the determined time is longer than a threshold time.”

Conclusion

In view of the remarks and the claim amendments, all of the claims are in condition for allowance. A formal notice to that effect is respectfully requested.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

No fees are believed due. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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